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REMARKS/ARGUMENTS

Reconsideration of this application and entry of the foregoing amendments are respectfully requested.

The title has been revised to be more clearly indicative of the invention to which the claims are directed.

Claim 8 has been revised so as to be placed in independent form, thereby mooting the Examiner's objection. Claim 8 has been further revised to make reference to "an isolated" nucleic acid and to more clearly define the nature of the polypeptide having telomerase catalytic activity - support for the latter revision can be found throughout the application, including in claims 2 and 3 as originally filed. Claim 9 has been revised to delete the reference to "functional portion or variant thereof." That the claims have been revised should not be taken as an indication that Applicants agree with any position taken by the Examiner. Rather the revisions have been made merely to advance prosecution and Applicants reserve the right to pursue any deleted subject matter in a continuation application.

Claim 10 has been revised so as to be placed in independent, and thus allowable, form. New claims 25-41 have been added. The new claims are fully supported by the disclosure, including claims 2-7 and 11-23 as originally filed.

Claims 8-10 stand rejected under 35 USC 101 as allegedly being drawn to non-statutory subject matter. Withdrawal of the rejection is submitted to be in order in view of the above-noted revision of claims 8 and 10. Reconsideration is requested.

Claims 8, 9 and 11-23 stand rejected under 35 USC 112, first paragraph, as allegedly lacking written description. Withdrawal of the rejection is submitted to be in order for the reasons that follow.

In rejecting the claims as lacking written description, the Examiner appears to have overlooked the fact that the subject application does, in fact, include a variety of species reflective of the genus claimed. In this regard, the Examiner's attention is directed to, for example, page 4 of the application. The first full paragraph on that page relates to the portion of the chimeric molecule having telomerase catalytic activity. Reference is made there to 7 different patents describing polypeptides having telomerase catalytic activity. The disclosures of those patents are incorporated by reference at page 15, last paragraph.

As regards the telomere binding polypeptide component of the chimeric molecule, attention is directed to the paragraph bridging pages 4 and 5 of the application where specific reference is made to 9 different moieties, with 10 references being cited (which are also incorporated by reference on page 15).

Clearly the specification describes far more than SEQ ID NO:1. Indeed, Applicants submit that the disclosure conveys with more than reasonable clarity that Applicants were in possession of the invention as claimed as of the filing date.

In view of the above, the Examiner is requested to explain why the description provided is not sufficient or withdraw the rejection.

Claims 8, 9 and 11-23 stand rejected under 35 USC 112, first paragraph, as allegedly being non-enabled. Withdrawal of the rejection is submitted to be in order for the reasons that follow.

As described above in response to the rejection based on lack of written description, the subject specification is replete with examples of polypeptides having telomerase catalytic activity suitable for use in the chimeric molecule and telomere binding polypeptides suitable for use. The Examiner is urged to explain why, based on the extensive disclosure provided, one

skilled in the art could not practice the invention as claimed without undue experimentation so that Applicants can properly respond.

Applicants direct the Examiner's attention to the Court's decision in In re Angstadt and Griffin, 190 USPQ 214 (CCPA 1976) which is an enablement case that is believed relevant to the present situation. In Angstadt, the Court acknowledged that Appellants had not disclosed every catalyst that would work in the claimed chemical process and addressed the question of whether, in an unpredictable art, the enablement requirement of 35 USC 112, first paragraph, requires disclosure of every species encompassed by the claims. The Court found that there was no such requirement, pointing out that:

"such a requirement would force an inventor seeking adequate patent protection to carry out a prohibitive number of actual experiments. This would tend to discourage inventors from filing patent applications in an unpredictable area since the patent claims would have to be limited to those embodiments which are expressly disclosed."

The Court concluded that, having decided that disclosure of every species encompassed by the claims is not required, even an unpredictable art, each case must be determined on its own facts. In Angstadt, the Court found that Appellants' disclosure of a list of catalysts and details of how to make and use them to be sufficient. The Court pointed out that the experimentation required to determine which species would work would not be undue and would certainly not "require ingenuity beyond that to be expected of one of ordinary skill in the art" (citing Fields v. Conover, 170 USPQ 276, 279 (CCPA 1971)).

The facts in Angstadt are similar to those at hand. Here, the disclosure includes multiple polypeptides suitable for use in the chimeric molecule encoded by the claimed nucleic acid. Given the holding in Angstadt, nothing more should be required.

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NIXON VANDERHYE PC

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Applicants respectfully submit that no burden of undue experimentation would be required in order for the skilled person to practice the claimed invention. Accordingly, reconsideration is requested.

Claims 8, 11, 12, 17 and 23 stand rejected under 35 USC 102(b) as allegedly being anticipated by Evans et al. Withdrawal of the rejection is submitted to be in order in view of the above-noted claim revisions. Reconsideration is requested.

This application is submitted to be in condition for allowance and a Notice to that effect is requested.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____

Mary J. Wilson

Mary J. Wilson
Reg. No. 32,955

MJW:tat
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100